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04 JUL 12 AM 11:16

To: **Examiner: Ian J. Lobo**
Licensing and Review
U.S. Patent and Trademark Office
PO Box 1450, Alexandria, VA 22313-1450
RE: Application No. 09/824,483 (Tokuhiro et al.)
Our Ref.: 39303-2023900

Facsimile: (703) 746-3645
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From: Mehran Arjomand

Date: July 12, 2004

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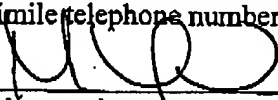
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Response To Denial Of Petition For Retroactive License Under 37 CFR 5.25 (7 pp)
Facsimile Transmittal (1 pg)

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Dated: July 12, 2004

Signature: 

(Mehran Arjomand)

Docket No.: 393032023900
Client reference: PA0009US (H7450US)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Taro TOKUHIRO et al.

Application No.: 09/824,483

Filed: March 30, 2001

For: METHOD FOR SELLING ITEMS USING A
NETWORK

Group Art Unit: 3625

JUL 12 2004

Examiner:
Mark Fadok (Examination)
Ian Lobo (Licensing/Review)

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RESPONSE TO DENIAL OF PETITION FOR RETROCATIVE LICENSE

UNDER 37 CFR 5.25

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to a denial of a petition for a retroactive license under 37 CFR 5.25 mailed on May 24, 2004, requesting a response within 60 days of the mailing date. Enclosed herewith is copy of the denial.

Applicants note with appreciation the Examiner's courtesy during the telephone interview on July 12, 2004. As discussed, Applicants submitted a petition for retroactive license concurrently with the filing of the application on March 30, 2001. The petition received the serial

la-735302

Application No.: 09/037,822

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number P-104,003. The petition was subsequently reviewed, and a retroactive foreign filing license bearing number 527,180 was granted on July 9, 2001. As requested by the Examiner, enclosed herewith is a copy of the Office communication dated July 11, 2001 granting the license. Thus, Applicants respectfully submit that a retroactive foreign filing license has been granted, and the denial of the petition on May 24, 2004 should be withdrawn.

If, for any reason, the Examiner needs further assistance, Applicants request that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5630.

In the unlikely event that the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 393032023900.

Dated: July 12, 2004

Respectfully submitted,

By 

Mehran Arjomand

Registration No.: 48,231

MORRISON & FOERSTER LLP

555 West Fifth Street, Suite 3500

Los Angeles, California 90013

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la-735302



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

David L. Fehrman
Morrison & Foerster LLP
555 West Fifth Street, Suite 3500
Los Angeles, California 90013-1024

In re: Tokuhito et al : DECISION ON REQUEST
Serial No.: 09/824,483 : UNDER 37 CFR 5.25
Filing date: March 30, 2001
Docket No: 39303.2023900

Title: METHODS FOR SELLING ITEMS USING A NETWORK

This is a decision on the petition filed on May 5, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied under 37 CFR 5.25 (3)(iii). In order to secure a retroactive foreign filing license, applicant or petitioners must provide evidence that the subject matter was filed abroad through error and without deceptive intent. The instant petition fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and without deceptive intent. Specifically, the petition needs to elucidate upon circumstances that led to discovery of the proscribed filing. Mr. Mizuno avers that "during this time, (presumably between March 9, 2001 and March 20, 2001 he became aware of possible filing license requirements for inventions made in the US". However, the statement regarding awareness of the proscribed filing is not supported by facts (i.e., copies of any necessary supporting documents such as letters of transmittal or instructions for filing) to support the statement of error of filing and more

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specifically, the circumstances of when and how he became aware of the requirements and thus the error of filing abroad before securing a foreign filing license.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Ian J. Lobo
Patent Examiner
(703) 306-4161

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
P-104,003	4/9/01	TARO TOKUHIRO, ET AL	39303.20239

Title: METHOD FOR SELLING ITEMS USING A NETWORK

Correspondence Address:

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LICENSING & REVIEW

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 527,180

Grant Date: 09-Jul-01

This license is granted retroactively to
the date(s) and the country(s) indicated
on the attached decision.

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/824,483	05-May-04	TARO TOKUHIRO, ET AL.	39303.20239.00

Title: METHOD FOR SELLING ITEMS USING A NETWORK

Art Unit	Paper Number
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Correspondence Address:

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5/24/04

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.

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MAILED

JUL 11 2001

LICENSING & REVIEW

In re:	Tokuhiro et al.	:	DECISION ON PETITION
Petition No.:	P-104,003	:	UNDER 37 CFR 5.25 FOR
Filing date:	April 9, 2001	:	RETROACTIVE FOREIGN
Docket No:	39303.20239	:	FILING LICENSE

Title: Method For Selling Items Using A Network

This is a decision on the petition filed on April 9, 2001 for a retroactive foreign filing license. At the time of the filing, the declaration of Shigehiko Mizuno indicates that the application was filed in error. In that the error was discovered in March of 2001 and the petition being filed immediately thereafter, the requirement of diligence has been met. This conclusion is supported by the facts recited in the declarations.

In view of the above facts and statements, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 through error and without deceptive intent.

Country

Date

Japan

EPO

Korea

Singapore

China

March 9, 2001

March 9, 2001

3/22/01

12/28/00

George L. Steele
Patent Examiner

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